

REMARKS

Claims 1-4, 6-11, 13-19 and 21-22 are rejected under 35 U.S.C. §102(e) as being anticipated by *Jain* (U.S. 6,480,853). Applicants traverse this rejection on the grounds that this reference is defective in supporting a rejection under 35 U.S.C. §102.

Independent claims 1, 8, 16, 21 and 22 include:

“A method comprising:

storing a bookmark;

receiving a search term and an identifier associated with the bookmark;

searching a database using the search term and the identifier;

searching a website associated with the bookmark using the search term and the identifier; and

displaying an advertisement associated with the bookmark and the identifier in response to a result of the search.”

The PTO provides in MPEP §2131...”To anticipate a claim, the reference must teach every element of the claim...”. Therefore, to sustain this rejection the *Jain* patent must contain all of the claimed elements of claims 1, 8, 16, 21 and 22. However, the claimed search term and specific identifier for one or more stored bookmarks is not shown or taught in the *Jain* patent. Therefore, the rejection is unsupported by the art and should be withdrawn.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, contained in the ...claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claims 5, 12 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Jain* in view of *Himmell et al.* (U.S. 6,324,566).

Applicants traverse these rejections on the grounds that these references are defective in establishing a *prima facie* case of obviousness.

As the PTO recognizes in MPEP § 2142:

...The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness....the Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made....The Examiner must put aside knowledge of the Applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'"

The combined references fail to teach or suggest storing one or more bookmarks and using a search term along with a specific identifier for the bookmark used in a search.

Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection because neither reference teaches or even suggests the desirability of the combination. Moreover, neither reference provides any incentive or motivation supporting the desirability of the combination.

The MPEP §2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Therefore, the Examiner's combination arises solely from hindsight based on the invention without any showing of suggestion, incentive or motivation in either reference for the combination.

Thus, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met.

The Federal Circuit has, on many occasions, held that there was no basis for combining references to support a 35 U.S.C. §103 rejection. For example, in *In re Geiger*, the court stated in holding that the PTO "failed to establish a *prima facie* case of obviousness":

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Monteffiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

The Federal Circuit has also repeatedly warned against using the applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. See, e.g., *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1798, 1792 (Fed. Cir. 1989).

More recently, the Federal Circuit found motivation absent in *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). In this case, the court concluded that the board had "reversibly erred in determining that one of [ordinary] skill in the art would have been motivated to combine these references in a manner that rendered the claimed invention [to have been] obvious." The court noted that to "prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the

case of obviousness." The court further noted that there were three possible sources for such motivation, namely "(1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art." Here, according to the court, the board had relied simply upon "the high level of skill in the art to provide the necessary motivation," without explaining what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Notably, the court wrote: "If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance."

Therefore, independent claims 1, 8, 16, 21 and 22 and the claims dependent therefrom are submitted to be allowable.

In view of the above, it is respectfully submitted that claims 1-4, 6-11, 13-19, 21 and 22 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

Respectfully submitted,



James R. Bell
Registration No. 26,528

Dated: 1-21-04
HAYNES AND BOONE, L.L.P.
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 512/867-8407
Facsimile: 214/200-0853
ipdocketing@haynesboone.com

A-156832_1.DOC

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.	
on	<u>1/21/04</u>
Date	<u>Nishi</u>
Signature	<u>Nishi Pasarya</u>
Typed or Printed name of person signing Certificate	